



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,052	11/12/1999	KELVIN RODERICK LAWRENCE	AT9-98-146	1180

34619 7590 12/03/2002

PAUL D. HEYDON, PATENT ATTORNEY  
909 NE LOOP 410, SUITE 300  
SAN ANTONIO, TX 78209

EXAMINER

WONG, LESLIE

ART UNIT PAPER NUMBER

2177

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



**UNITED STATES PATENT AND TRADEMARK OFFICE**

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 2

Application Number: 09/439,052  
Filing Date: November 12, 1999  
Appellant(s): LAWRENCE ET AL.

\_\_\_\_\_  
Paul D. Heydon  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**

DEC 03 2002

Technology Center 2100

This is in response to the appeal brief filed 23 August 2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

The rejection of claims 22-24 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

✓ 5,987,457	BALLARD	11-1999
✓ 5,886,698	SCIAMMARELLA	3-1999
✓ Takano, H and Winograd, T. "Dynamic Bookmarks for the WWW" Computer Science Department, Stanford University, 1998, pp. 297-298		

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:  
Claims 22-24 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 7

**(11) Response to Argument**

Appellants argue that the rejection of claims 22-24 is erroneous and that the Examiner did not establish a *prima facie* case of obviousness because the references

Art Unit: 2177

do not teach or suggest all the claimed limitations. In particular, Appellants argue that the references do not describe the following claimed limitations:

“marking URL’s positive or negative regarding whether a user’s needs are met by search results”,

“submitting a bookmark set to a search engine”, and

“repeating (a) to (c) as often as said user desires to refine said search results to a manageable level”

Appellants further submit that URL’s are not mentioned by Ballard and Sciammarella requires the user to enter one or more keywords as input. Additionally, Appellants argue that Takano and Winograd do not describe a positive or negative marking, nor do they describe input regarding whether a user’s needs are met by search results.

In response to the preceding arguments, the Examiner respectfully submits that Ballard’s refinement method requires the user to provide feedback by marking whether the URLs are “of interest” or “not of interest”. Terms such as, of interest or not of interest, relevant or irrelevant, and desirable or not desirable are analogous and usually convey the same meanings as positive or negative. Thus, Ballard’s categorization of the URLs (i.e., documents) by indicating whether a URL is “of interest” or “not of interest” in order to group the search results based on the user’s needs is similar to Appellants’ limitation of marking URL’s positive or negative. Consequently, Ballard’s

Art Unit: 2177

teachings satisfy the claimed limitation of marking URL's positive or negative regarding whether a user's needs are met by search results.

The Examiner further submits that ordinarily a search engine processes any user submitted search request by examining entered keywords. Therefore, the claimed limitation of "submitting a bookmark set to a search engine" should inherently submit the search requests in the bookmark set to the search engine for further processing. Appellants' Specification is silent on how the bookmark set is processed by the search engine. For instance, on page 9, lines 27-30 of the Specification merely discloses the following:

"Subsequently, the bookmark set with rating is resubmitted to the search at 306."

As one skilled in the art would know that search engine does not process a request based on URLs. Clearly, from the foregoing textual portions, such claimed limitation must be implicit from Ballard's teachings.

Additionally, the Examiner submits that Ballard inherently teaches the search refining process by allowing the user to indicate that the refined query phrase is ready to be submitted for searching (col. 6, lines 54-60). Hence, this satisfies the limitation of repeating the search refining process until the search results is at a manageable level.

The Examiner also points out that when a user submits a search request via an Internet, a list of search results (i.e., URLs for the matched documents) is returned for review. It is inherent that Internet search results return documents as URLs. For example, Takano and Winograd is a proof of such inherency. Therefore, Ballard's does not have to mention the URLs in particular.

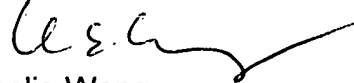
The Examiner finally submits that Ballard either explicitly or implicitly teaches all limitations of the claimed invention. Sciammarella and Takano and Winograd are brought in as further proof or reinforcement of Ballard's inherencies (URL and repeating steps of search refinement).

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/439,052  
Art Unit: 2177

Page 7

Respectfully submitted,



Leslie Wong  
Patent Examiner  
Art Unit 2177

lw  
November 29, 2002

Conferees

Jean R. Homere

Srirama T. Channavajjala



DAVID A MIMS JR  
IBM CORPORATION  
INTELLECTUAL PROPERTY LAW DEPARTMENT  
11400 BURNET ROAD INTERNAL ZIP 4054  
AUSTIN, TX 78758.



JEAN R. HOMERE  
PRIMARY EXAMINER